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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,474	10/22/2003	Pamela Cifra	020154-001210US	7244

20350 7590 11/16/2006

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EXAMINER

BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,474

Applicant(s)

CIFRA ET AL.

Examiner

Thomas C. Barrett

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 1-50, 55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-54, 57-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the invention of Group III (claims 51-54 and 57-62), drawn to a medical device, comprising the species of binding Zinc as in Fig. 5 in the reply filed August 21, 2006, is acknowledged.

Applicant's traversal is on the grounds that search and examination of the entire application can be made without serious burden to the Examiner, in particular, because the devices of Group III are used in the methods of Group I. Applicant's traversal has been carefully considered, but fails to establish error in the propriety of the present requirement for restriction and election.

Though Applicant asserts that examination of all pending claims would not pose an undue burden on the Examiner, such is not an accurate assertion in light of the disparate nature of the presently claimed subject matter as noted in the Requirement for Restriction of July 20, 2006.

Consideration of the plurality of inventions that Applicant has claimed would significantly compromise and preclude a quality examination on the merits. Furthermore, execution of a search encompassing the entirety of Applicant's methods and devices would not only constitute an undue burden on the Examiner, but consideration of the findings of such a search in accordance with the requirements of the law under 35 U.S.C. §101, 102, 103 and 112 would be unduly onerous.

Moreover, it is further noted that a comprehensive search for the presently claimed subject matter is not solely limited to a search of the classes and subclasses in

Art Unit: 3738

which they are classified. Therefore, it is obvious that a comprehensive search of the copious amounts of patent and non-patent literature for each of the patentably distinct inventions and their permutations presently claimed would necessarily place an undue burden on the Examiner.

Therefore, for the reasons above and those made of record in the Requirement for Restriction of July 20, 2006, the restriction requirement is deemed proper and is made FINAL.

Claims 1-50 and 55-62 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b), as being to non-elected inventions, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 51-54, and 57-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogle (6,113,636). Ogle discloses a device comprising: at least one implantable medical device; and at least one zinc-salt (e.g. zinc nitrate col. 7, lines 15-29) containing component coupled with the device, e.g. a graft (col. 5, lines 40-51) in a concentration between 1.0 picomolar and about 500 millimolar (e.g. col. 7, lines 58-66).

Please note that the present specification discloses:

Art Unit: 3738

Devices, zinc-containing components, and means for coupling devices and zinc are typically selected to provide for the release of ionic zinc from the device at a location to have a desired effect on a tissue or similar substance. For example, devices used in various embodiments of the present invention may be made by various known techniques, such as those described in U.S. Pat. Nos. 6,113,636, 6,190,407, 6,267,782 and 6,322,588, the complete contents of which are hereby incorporated by reference. Such techniques involve depositing a metal or compound, such as zinc or a zinc compound on the surface of a device (for instance a stent or implant) formed from a suitable biocompatible material such as stainless steel, titanium, nitinol, ceramics, polytetrafluoroethylene, silastic, polylactide, polyglycolide, polylactide-co-glycolide, and the like, acrylates, methacrylates, polyurethane, or combinations of these. Other biocompatible materials or compounds may similarly be used in such devices. Deposition may be carried out either on a device already formed or on biocompatible material that will subsequently be used for production of such a device. The deposition is carried out by techniques such as incubation of the device or biocompatible material with a solution of a zinc salt, as described in U.S. Pat. No. 6,113,636. Alternatively, the zinc may be deposited on the device or biocompatible material in the form of elemental zinc. U.S. Pat. No. 6,113,636 describes processes for producing such a zinc-containing material, including chemical reduction, photochemical reduction, and electrodeposition or electroplating. Also, as described in that patent, a combination of elemental zinc and a zinc salt may be deposited on the material.

The graft of Ogle is made by the same method as the present invention as admitted by the present specification and therefore has the same properties, e.g. plaque inhibition, as that which are claimed.

Claims 51 and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Tam et al. (6,261,320). Tam et al. discloses a device comprising: at least one implantable medical device (e.g. Fig. 10); and at least one zinc-containing component (e.g. column 27, line 53- col. 28, line 17) coupled with the device, wherein the zinc-containing component is primarily on a tissue-facing surface (col. 31, lines 21-32).

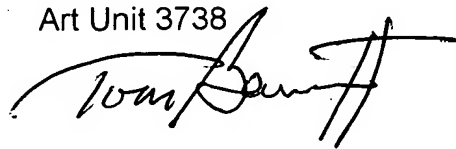
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746. The examiner can normally be reached on Mon. -Fri. from 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas C. Barrett
Examiner
Art Unit 3738



TOM BARRETT
PRIMARY EXAMINER
TECHNOLOGY CENTER 3700